

Customer No. 27061
Confirmation No. 5745

Patent
Attorney Docket No. GEMS8081.023

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Durbin et al.
Serial No. : 09/681,017
Filed : November 22, 2000
For : METHOD AND SYSTEM TO REMOTELY ENABLE
SOFTWARE-BASED OPTIONS FOR A TRIAL PERIOD
Group Art No. : 3621
Examiner : Calvin Loyd Hewitt II

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

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37 CFR 1.8(a)

37 CFR 1.10

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Transmission

- ☐ transmitted by facsimile to Fax No.: 571-273-8300 addressed to Examiner Calvin Loyd Hewitt II at the Patent and Trademark Office.
☒ transmitted by EFS-WEB addressed to Examiner Calvin Loyd Hewitt II at the Patent and Trademark Office.

Date: June 12, 2007

/Robyn L. Templin/
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND
RULES OF 37 C.F.R. §1.131

Dear Sir:

In response to the Decision on Petition mailed April 12, 2007, Applicant submits this Renewed Petition under 37 C.F.R. § 1.183. Applicant respectfully requests suspension of the requirements of 37 C.F.R. § 1.131 in order to proceed with the previously-filed Antedating Declaration without the signatures of joint inventors Karamjeet Singh and Kun Zhang.

REMARKS

Applicant hereby petitions for suspension of the requirement of 37 C.F.R. §1.131 that all joint inventors must participate in a Declaration establishing invention of the claimed subject matter prior to the effective date of a cited reference. Joint inventors Karamjeet “KJ” Singh and Kun Zhang are no longer employed by the Assignee of the present application. Joint inventor Singh has not agreed to sign an antedating declaration and joint inventor Zhang has been unreachable. The remaining joint inventor, Winnie Durbin, did sign the Declaration Under § 1.131, filed on March 26, 2007.

As a preliminary matter, the Decision on Petition mailed April 12, 2007 (“the Decision”) commented that “Durbin’s declaration implies Zhang and Singh only contributed to the reduction to practice of the invention.” *Decision*, 04/12/07, pg. 2. Joint inventors Zhang and Singh did contribute to the reduction to practice of the invention. However, such a reduction to practice is not to the exclusion of a contribution to the conception of at least a portion of the invention, as claimed. As set forth below, joint inventors Zhang and Singh are properly listed as inventors of the present application.

In substance, the Decision dismissed Applicant’s Petition Under §1.183 filed March 26, 2007 (“the Petition”), stating that “Petitioner has failed to prove the two non-signing inventors are deceased, have refused to sign, or are unavailable.” *Decision*, 04/12/07, pg. 2. The Decision further stated that

“The Office has stated the signature requirements can be waived in certain circumstances. (1) The assignee or other party in interest can sign the affidavit or declaration if none of the inventors will sign the declaration. See MPEP 714. (2) The affidavit or declaration can be signed by fewer than all the inventors if the other inventors are deceased, refuse to sign, or are unavailable. The affidavit or declaration must show reduction to practice or conception of the invention coupled with due diligence by the non-signing inventors.”

Decision, 04/12/07, pg. 1. Conspicuously, no citation is offered as support for the stated legal standard for the second alternative (fewer than all inventors signing). According to 37 C.F.R. §1.183, “In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived ... on petition of the interested party.” (Emphasis added.) This section makes no mention of specific showings relating to inventors who “are deceased, refuse to sign, or are unavailable.” Rather, it is 37 C.F.R. §1.47 which discusses inventors who “refuse[] to join in an application” or who “cannot be found or reached after diligent effort.” The instant Decision, however, makes clear that it is §1.183, and not §1.47, which applies. *See Decision*, 04/12/07, pg. 1, n. 1. Applicant believes

that it is this conflation of legal standards and regulatory requirements which led to the dismissal of the Petition of March 26, 2007. That is, Applicant finds no statute, regulation, or MPEP section which specifically requires a showing of death, refusal to sign, or unavailability for petitions under §1.183.

If a refusal to sign or unavailability is properly required in order to suspend the rules of §1.131, the circumstances leading to the present lack of signatures meet such requirements. Beginning on January 29, 2007 Applicant's representative, the undersigned, attempted to contact joint inventors Kun Zhang and Karamjeet Singh in order to obtain their signatures on the attached Declaration Under §1.131. An email correspondence to joint inventor Zhang's last known email address was returned as undeliverable. Attached hereto as Exhibit A is a copy of the returned email. The undersigned further attempted to call Mr. Zhang at his last known business number, but was unable to reach Mr. Zhang. Copies of internet search pages further exemplifying the undersigned's attempts to find joint inventor Zhang are attached as Exhibit B. Administrators at the Assignee corporation have confirmed that Mr. Zhang is no longer employed by the Assignee and that no current contact information is maintained for departed inventors. Joint inventor Zhang's present contact information, occupation, address, and country of residence are unknown.

Likewise, joint inventor Singh has confirmed that he is no longer employed by the Assignee. Attached as Exhibit C is a January 31, 2007 email correspondence from Mr. Singh stating as such and indicating a willingness to assist in the prosecution of the present application. An electronic copy of an antedating Declaration Under §1.131 and the Invention Disclosure included as an Exhibit thereto were sent to Mr. Singh on February 16, 2007. A copy of such email is attached hereto in Exhibit D. A voicemail was left for Mr. Singh the week of February 19, 2007, but did not elicit a response from Mr. Singh. On February 26, 2007, additional copies of the Declaration Under § 1.131 and the Invention Disclosure were sent to Mr. Singh. However, on the same day Mr. Singh sent an email (a copy of which is attached as Exhibit E) to the undersigned stating that he wanted to "verify his employment dates" prior to execution of the Declaration under §1.131. The executed declaration of inventorship (filed on February 9, 2001) was forwarded to Mr. Singh to remind him of his previous participation in this patent application, but Mr. Singh still did not agree to sign the Declaration under §1.131. The undersigned spoke to Mr. Singh several times on February 26, 2007, to discuss the matter. Mr. Singh indicated that he was unfamiliar with the Invention Disclosure and could not recall with sufficient particularity exactly when he conceived of his contribution to the present invention, though Mr. Singh did acknowledge that he is properly listed as an inventor of the present application.

The undersigned also called joint inventor Durbin on February 26, 2007, after she had already signed the Declaration Under §1.131. Ms. Durbin again confirmed to the undersigned that the Invention Disclosure included with the Declaration Under § 1.131 does correspond to the present invention and that Mr. Singh is an inventor. The undersigned called Mr. Singh once more to relate Ms. Durbin's statements, and invited Mr. Singh, both verbally and via an email attached hereto in Exhibit F, to call Ms. Durbin himself. The undersigned contacted Ms. Durbin as recently as March 26, 2007, but Ms. Durbin indicated that she still has not been contacted by Mr. Singh. On March 3, 2007, Mr. Singh sent an email to the undersigned (attached in Exhibit F) indicating an unwillingness to sign the Declaration Under § 1.131. Mr. Singh did not respond to an email sent to him by Atty. Timothy J. Ziolkowski on March 5, 2007. The undersigned has not received further phone calls or emails from Mr. Singh.

Accordingly, Applicant believes that it should not be prejudiced by the lack of signatures from a missing former employee and an uncooperative former employee, especially since Applicant has supplied the signature of at least one of the inventors on the Declaration Under § 1.131, filed March 26, 2007 along with evidence of a conception of the invention.

Applicant therefore respectfully renews the request of March 26, 2007 for suspension of the rules of §1.131 and entry of the Declaration Under §1.131 filed on the same date. The fee under 37 C.F.R. 1.17(f) for making this Petition Under §1.183 has already been paid via EFS-WEB. No additional fee is believed due. Applicant appreciates the consideration of this Renewed Petition and invites the Office of Petitions to contact the undersigned, should any matters be considered unresolved.

Respectfully submitted,

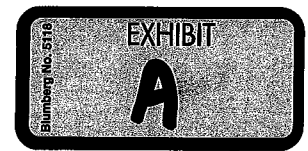
/Stephen J. Gardner/

Stephen J. Gardner
Registration No. 59,057
Phone: 262-268-8100, ext. 17
sjg@zpspatents.com

Dated: June 12, 2007
Attorney Docket No.: GEMS8081.023

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
136 S. Wisconsin St.
Port Washington, WI 53074
262-268-8100



2007.01.29 Undeliverable Zhang.txt

From: System Administrator [postmaster@gecapital.com]
Sent: Monday, January 29, 2007 12:34 PM
To: Steve Gardner
Subject: Undeliverable: Patent Application for Remotely Enabling
Software Options / Flex-Trial (15-SV-5377 / 8081.023)

Attachments: Patent Application for Remotely Enabling Software Options /
Flex-Trial (15-SV-5377 / 8081.023)

Your message

To: [REDACTED] kun.zhang@med.ge.com
Subject: Patent Application for Remotely Enabling Software Options / Flex-Trial
(15-SV-5377 / 8081.023)
Sent: Mon, 29 Jan 2007 13:24:25 -0500

did not reach the following recipient(s):

KUN.ZHANG@MED.GE.COM on Mon, 29 Jan 2007 13:34:12 -0500

The recipient name is not recognized

The MTS-ID of the original message is:

c=us;a=mark400;p=ge;l=IMC0701291834DLSNR9SN

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center.spoke.com/info/index-person/ze-zi-35 - 55k - Cached - Similar pages - Note this

Wei **Zhang** — Xumu **Zhang** : ZoomInfo Business People Information

Zhang, Wenwu, **General Electric** Company, Wenwu **Zhang**, GE Global Research; Schenectady NY USA **Zhang**, Xiao, Athabasca University, Xiao Kun **Zhang** ...
www.zoominfo.com/people/level2page44480.aspx - 91k -
Cached - Similar pages - Note this

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Zhang, Xiaomang; to Sharp Kabushiki Kaisha Image processing apparatus 07116819 Cl. Zhuo, Zhangqing; and Tong, Wei, to **General Electric** Company Flexible ...
www.uspto.gov/web/patents/patog/week40/OG/patentee/alphaZ.htm - 37k -
Cached - Similar pages - Note this

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Huang, Shi-Kun; Zalipsky, Samuel; and **Zhang**, Wei-Ming 07112337 Cl. 424-450. Zhou, Yong; and King, Kevin Franklin, to **General Electric** Company Eddy ...
uspto.gov/web/patents/patog/week39/OG/patentee/alphaZ_Utility.htm - 24k -
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The World's Most Respected Companies 2005, Microsoft, **General** ...

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0, 26, **Zhang** Ruimin, Haier - China's largest white goods company ...
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TMIC-2, An adaptive neural network **general** generalized predictive control and Kun **Zhang** (Tsinghua University). Chun Yuan (Tsinghua University) ...
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... Rzesutek, Leszek; and Altman, John Edward, to **General Electric** Company **Zhang**, Jingdan; Zhou, Kun; Guo, Baining; and Shum, Heung-Yeung 07110000 Cl. ...
www1.uspto.gov/web/patents/patog/week38/OG/patentee/alphaZ_Utility.htm - 36k -
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Dawson, Marcia; Fontana, Joseph A.; **Zhang**, Xiao-kun; Leid, Mark; Jong, Ling; and Hobbs, ... Zhu, Yudong; to **General Electric** Company Method and apparatus to ...
www1.uspto.gov/web/patents/patog/week22/OG/patentee/alphaZ_Utility.htm - 28k -
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Body GU

Kun Cao¹, Xiaopeng **Zhang**¹, Lei Tang¹, Yingshi Sun¹ Hamamatsu, Shizuoka, Japan;
2General Electric Yokogawa Medical Systems, Hino, Tokyo, Japan ...
www.ismrm.org/06/ep24.htm - 21k - Cached - Similar pages - Note this

[PDF] A case of schwannoma in the tongue diagnosed with enhanced ...

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magnet (Signa LX, **General Electric**, Milwaukee, WI, USA). with a head coil. **Kun** Z, Qi
D-Y, **Zhang** K-H. A comparison between the clinical ...
www.springerlink.com/index/XNCU94VW8BHWY8L2.pdf - Similar pages - Note this

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Kenneth Zhang	Milwaukee, WI	53	View Details
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2007.01.31 KJ RE new contact info.txt

From: [REDACTED]
Sent: Wednesday, January 31, 2007 2:29 PM
To: Steve Gardner
Subject: FW: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)

Hi, Steve.

Please note my new email and phone number as listed below:

[REDACTED]
[REDACTED] (cell)
[REDACTED] (home)
[REDACTED] (work)

Let me know how I can help. I am no longer employed by GE Medical Systems.

Thanks,

KJ

~~~~~  
From: Steve Gardner [mailto:sjg@zpspatents.com]  
Sent: Tuesday, January 30, 2007 10:56 AM  
Subject: FW: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)

KJ,

I am trying to track down inventors on a patent application drafted by Tim Ziolkowski a few years back. Please see the below email and respond if this is still a current email address for you. We may ask for your assistance in overcoming a rejection.

Thanks!

Steve Gardner

---

From: Steve Gardner  
Sent: Monday, January 29, 2007 12:24 PM  
To: [REDACTED]; 'kun.zhang@med.ge.com'  
Subject: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)

Winnie and Kun,

My name is Steve Gardner - I am a patent attorney working with Tim Ziolkowski on a patent application of yours. We received a disclosure in [REDACTED] and filed an application in Jan. 01 on a system for enabling software options in remote products. The USPTO has issued a rejection of the application based on a reference dated Dec. 1999.

By this email I am seeking to determine whether you are still employed at GE and whether you will be available to sign an affidavit attesting to the prior date of invention for this patent application.

Thanks  
Steve

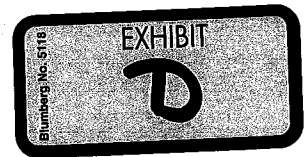
2007.01.31 KJ RE new contact info.txt

Stephen J. Gardner, CE JD  
Ziolkowski Patent Solutions Group, SC  
136 South Wisconsin Street  
Port Washington WI 53074  
Phone: 262-268-8100, Ext 17  
Fax: 262-268-8185  
sjg@zpspatents.com

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2007.02.16 Ant. Dec. to inventors.txt

From: Steve Gardner  
Sent: Friday, February 16, 2007 2:06:33 PM  
To: [REDACTED]; [REDACTED]  
Subject: RE: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)

Attachments:  
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<Antedating Dec.doc>

<<Disclosure for 8081.023.pdf>> <<Antedating Dec.doc>>  
Winnie and KJ,

As I mentioned in my previous emails to you, the patent application for your invention on remotely enabling software options has been rejected based upon a prior patent filed in Dec. 1999. I have attached a copy of the GE invention disclosure corresponding to this application, which evidences conception of your invention prior to Dec. 1999. If you recall, a determination of proper inventorship (i.e. you) was made after the disclosure was written. Therefore, the names on the disclosure differ from the names on the application.

Also attached is a declaration form, attesting that you invented the subject matter of the application prior to Dec. 1999. Please review this form and, if you agree with it, sign the form and fax or email a copy to me, then mail the original. Of course, it is acceptable for you to sign separate pages. There's no need to for the two of you to try to sign the same physical sheet.

If you have any questions at all, please don't hesitate to call or email. Thanks!

Steve Gardner

---

From: Steve Gardner  
Sent: Monday, January 29, 2007 12:24 PM  
To: [REDACTED]; [REDACTED]  
Subject: Patent Application for Remotely Enabling Software Options / Flex-Trial (15-SV-5377 / 8081.023)

Winnie and Kun,

My name is Steve Gardner - I am a patent attorney working with Tim Ziolkowski on a patent application of yours. We received a disclosure in [REDACTED] and filed an application in Jan. 01 on a system for enabling software options in remote products. The USPTO has issued a rejection of the application based on a reference dated Dec. 1999.

By this email I am seeking to determine whether you are still employed at GE and whether you will be available to sign an affidavit attesting to the prior date of invention for this patent application.

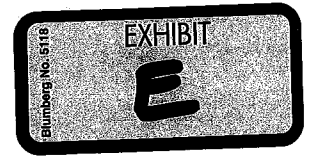
Thanks  
Steve

Stephen J. Gardner, CE JD  
Ziolkowski Patent Solutions Group, SC  
136 South Wisconsin Street  
Port Washington WI 53074  
Phone: 262-268-8100, Ext 17  
Fax: 262-268-8185  
sjg@zpspatents.com

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2007.02.26 KJ Re employment dates.txt

From: [REDACTED]  
Sent: Monday, February 26, 2007 1:23 PM  
To: Steve Gardner  
Subject: Re: Patent Application for Remotely Enabling Software Options / Flex-Trial  
(15-SV-5377 / 8081.023)

Steve,

Thanks for your call this morning. I will have to verify my employment dates before I can sign this declaration. I was employed by GEMS (X-ray division) before moving to GEMS Service Technology group (which filed for this patent) in 1999.

KJ

On Mon, 26 Feb 2007 09:15:51 -0600, Steve Gardner wrote

> KJ,  
> The fax number here at ZPS is: 262-268-8185. I attached copies of the disclosure and the declaration form. We are trying to file a response on this case today, so I really appreciate your help with this!  
> Thanks  
> Steve Gardner  
> <<Disclosure for 8081.023.pdf>> <<Antedating Dec.doc>>



2007.03.03 KJ Singh RE GE Patent.txt

From: [REDACTED]  
Sent: Saturday, March 03, 2007 8:12 PM  
To: Steve Gardner  
Subject: GE Patent

Hi, Steve.

After further consideration, I have decided that I am not comfortable signing the document(s). Thanks for your understanding.

Regards,  
KJ

On Thu, 1 Mar 2007 09:45:51 -0600, Steve Gardner wrote

> Hi KJ,  
>  
> Have you had a chance yet to get in touch with Winnie Durbin on this  
> matter?  
>  
> Thanks,  
> Steve Gardner  
>  
> -----Original Message-----  
> From: [REDACTED]  
> Sent: Monday, February 26, 2007 5:29 PM  
> To: Steve Gardner  
> Subject: Re: Winnie Durbin's cell number  
>  
> Steve,  
>  
> Unfortunately, I am unavailable tomorrow. I am open on Wednesday after  
> 3:00pm.  
>  
> Thanks,  
> KJ

>  
> On Mon, 26 Feb 2007 17:22:46 -0600, Steve Gardner wrote  
> > Hi KJ,  
> > I just spoke to Winnie Durbin. She seems to remember the  
> > preparation of  
> this patent application quite well. She will be available to talk to  
> you tomorrow after 9am. Her cell phone number where she can be  
> reached is: [REDACTED]  
> > Thanks for your help with this!  
> > Steve Gardner  
> > Stephen J. Gardner, CE JD  
> > Ziolkowski Patent Solutions Group, SC  
> > 136 South Wisconsin Street  
> > Port Washington WI 53074  
> > Phone: 262-268-8100, Ext 17  
> > Fax: 262-268-8185  
> > sjg@zpspatents.com  
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